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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/720,927	10/04/1996	ASHER GIL	PI/3C	2200

7590 07/17/2003

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EXAMINER

COSIMANO, EDWARD R

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 07/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

08/720,927

Applicant(s)

GIL ET AL.

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 October 1996 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 13 February 1998 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

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1. Applicant should note the changes to patent practice and procedure:

A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997; and

B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000.

2. A request for continued examination under 37 CFR § 1.114, including the fee set forth in 37 CFR § 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR § 1.114, and the fee set forth in 37 CFR § 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR § 1.114. Applicant's submission filed on September 30, 2002 has been entered.

3. The disclosure is objected to because of the following informalities:

A) it is noted that the 109 pages of paper appendices as filed October 04, 1996 does not comply with the requirements of 37 CFR § 1.96(c). Note pages 1, 9, 15 & 34 which mention the appendices.

Appropriate correction is required.

4. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

5. Claims 1-19 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-28 of copending Application No. 09/493,800. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

5.1 The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

A) receives input from an user;

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B) receives an item of mail;

C) weighs the item of mail;

D) determines the correct shipping fee/postage for the received item of mail;

E) receives payment from the user; and

F) if the fee is acceptable and has been paid, accepts the item of mail into a secured storage area.

5.2 Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

5.3 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

5.4 A timely filed terminal disclaimer in compliance with 37 CFR § 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR § 1.130(b).

5.5 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR § 3.73(b).

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6.1 Claims 5-12 & 16-19 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Ramsden (5,481,464).

7. It is noted that:

A) the effective filing date for the subject matter of claims 5-12 & 16-19, i.e. the transmission of user data to a central location is the filing date of the instant application, that is August 02, 1994, while,

B) the effective filing date for the subject matter of claims 5-12 & 16-19, i.e. the transmission of user data to a central location as copied from Ramsden ('464) is February 18, 1994.

Hence, the invention of claims 5-12 & 16-19 was known to others before the filing by applicant.

8. Response to applicant's arguments.

8.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

8.2 In regard to the requirement for the appendices, since the instant application is a continuation of U.S. Patent 5,586,037, which contains the requested appendices are part of U.S. Patent 5,586,037, those appendices were in the possession of applicant at the time the instant case was filed and are referenced in the instant disclosure. Hence, the proposed amendment to incorporate that appendix from U.S. Patent 5,586,037 would not be new matter and any such amendments would be approved by the examiner.

8.3 In regard to the obvious double patenting rejection, since applicant failed to either amend the claims around this rejection or to filed a proper terminal disclaimer, this rejection has been maintained by the examiner.

8.3.1 It is noted that the 09/493,800 application is now U.S. Patent No. 6,477,514.

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8.4 As per the 35 U.S.C. § 102(e) rejection, since:

A) the text referred to by applicant, (reproduced below):

“The customer is able to request an electronic mail operation (e.g., using a conventional electronic mail service such as MCI Mail) using one of the two types of floppy disc drives 124, 126 by inserting a floppy disk into the drive and following the voice/touch screen 110 instructions. The customer is thereby able to transmit his files to another computer. The cost of the electronic mail is deducted from the prepaid magnetic card and the card is returned to the customer.”;

merely enables:

(1) the insertion of a PREPAID MAGNETIC CARD containing a monetary value;

(2) the loading of electronic mail data;

(3) the transmitting of electronic mail data to a remote location;

(4) the deduction of the cost of transmitting the electronic mail data from the monetary value stored in/on the inserted PREPAID MAGNETIC CARD; and

(5) returning the inserted PREPAID MAGNETIC CARD to the owner of the card.

Therefore, it can not be seen how the above quoted text would enable one of ordinary skill to:

(1) in regard claims 5-9, to either:

(a) use a credit card, (note also claim 8); or

(b) insert a credit card, which is different than a PREPAID MAGNETIC CARD, i.e. a debit card, because a credit card does not store a monetary value; or

(c) the transmit credit data to a remote location for billing the customer.

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Since, payment in the 07/678,863 application is made at the “Automated Self-Service Package Shipping Machine” using a **PREPAID MAGNETIC CARD**.

(2) in regard to claim 7 to:

(a) transmit shipping manifest data to a remote location.

Since, in the 07/678,863 application only the electronic mail data is transmitted and while the manifest data is stored at the “Automated Self-Service Package Shipping Machine”.

(3) in regard claims 10-12 to either:

(a) transmit shipping fee data to a remote location for billing the customer; or

(b) use telephone lines to transmit the data.

Since, payment in the 07/678,863 application is made at the “Automated Self-Service Package Shipping Machine” using a **PREPAID MAGNETIC CARD**.

(4) in regard to claims 16-18 to:

(a) use a customer’s account for billing the shipping fee.

Since, payment in the 07/678,863 application is made by using a **PREPAID MAGNETIC CARD** at the “Automated Self-Service Package Shipping Machine”.

(5) in regard to claim 17 to:

(a) transmit shipping fee data to a remote location for billing the customer.

Since, payment in the 07/678,863 application is made at the “Automated Self-Service Package Shipping Machine” using a **PREPAID MAGNETIC CARD**.

(6) in regard to claims 9, 11 & 18 to:

(a) validate the credit card before issuing a shipping label for the customer.

Since, payment in the 07/678,863 application is made at the “Automated Self-Service Package Shipping Machine” using a **PREPAID MAGNETIC CARD**.

(7) in regard claim 19 to either:

- (a) transmit shipping fee data to a remote location for billing the customer; or
- (b) transmit shipping manifest data to a remote location; or
- (c) use telephone lines to transmit the data.

Since,

(a) payment in the 07/678,863 application is made at the "Automated Self-Service Package Shipping Machine" using a PREPAID MAGNETIC CARD; and

(b) in the 07/678,863 application only the electronic mail data is transmitted and while the manifest data is stored at the "Automated Self-Service Package Shipping Machine".

8.4.1 Further in regard to the 35 U.S.C. § 102(e) rejection, since, the payment processing required for either a credit card or debit card transaction as is well known is quite different and more extensive than the payment processing required for a prepaid card, which stores the remaining balance, the merely making a brief mention by applicant that payment could be made by credit card fails to provide the support required to enable the invention as now claimed.

8.4.2 It is further noted that applicant failed make an incorporation by reference to the disclosures of the parent applications. Therefore those disclosures do not form part of the instant disclosure, hence, applicant may not rely on any external disclosure in order to provide essential support for the presently claimed subject matter.

8.4.3 Hence, applicant's argument's are non persuasive.

9. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.



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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

10.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

10.2 The fax phone number for OFFICIAL FAXES is (703) 305-7687.

10.3 The fax phone number for AFTER FINAL FAXES is (703) 308-3691.

07/15/03

  
Edward R. Cosimano  
Primary Examiner A.U. 3629